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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,644	03/28/2001	Naonori Kato	33216M072	2473

7590

07/14/2004

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EXAMINER

STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 07/14/2004

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,644

Applicant(s)

KATO ET AL.

Examiner

Aaron Strange

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. Figures 2 and 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on March 31, 2000. It is noted, however, that applicant has not filed a certified copy of the 2000-097,136 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "said apparatuses" in line 6. There is insufficient antecedent basis for this limitation in the claim. Since Applicant claims "an apparatus of a plurality of apparatuses", it is unclear which apparatus(es) Applicant is referring to.

6. With further regard to claim 1, it is unclear what is "directed to said second network" in line 10. It appears that Applicant is referring to the instructions referred to in line 8, and it has been interpreted as such for the purpose of applying art.

7. With further regard to claim 1, the limitation "depending on the instructions when" is unclear. It appears as though a word may be missing between instructions and when, such as monitored, seen, or received. For the purpose of applying art, this has been interpreted to mean that instructions related to control of the device, which are seen by the monitoring means, are used when outputting control signals.

8. With regard to claim 2, the limitation "setting means in which" in line 2 is unclear. It is unclear how settings are set in setting means. Settings could be set by setting means or in some type of storage. For the purpose of applying art, this limitation has been interpreted simply as a means of setting control information in the gateway device.

9. With regard to claim 3, the limitation "is set in said control information setting means" in lines 2-3 is unclear. It is unclear how settings are set in setting means. Settings could be set by setting means or in some type of storage. For the purpose of applying art, this limitation has been interpreted in the same manner as claim 2.

10. With regard to claim 6, Applicant claims that identification information is acquired from "each of said" and "from all or part of said" apparatuses. The limitation "each of said" implies that information is acquired from all apparatuses, and "from all or part of

said" contradicts this. It is unclear which devices identification information is acquired from. For the purpose of applying art, this has been interpreted as acquiring information from all apparatuses of control objective.

11. With regard to claim 8, several phrases preceded by the recitation "said" lack antecedent basis, such as "said monitoring means" in line 3 and "said apparatuses" in line 4. The claim needs to be amended to provide antecedent basis for these limitations.

12. With further regard to claim 8, the claim language is unclear. Applicant uses means plus function language to claim elements of a program, but also states that each element is "in a gateway apparatus". Apparatus elements cannot be placed into a program, so it is unclear what Applicant intends to claim.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The program claimed in claim 8 is a program per se and since it is not tangibly embodied on a computer readable medium, it is merely a manipulation of abstract ideas.

15. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of Applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edson (US 6,526,581) in view of Daniels (US 2002/0032907).

18. With regard to claims 1 and 8, Edson discloses a gateway apparatus (Fig 1, 13) connected to a first network (Fig 1, 15, 17, or 19) and a second network (Fig 1, 23 or 21) and for controlling the operation of an apparatus or a plurality of apparatuses (Fig 1, 31, 32, 33, 34, 41, or 42) of control objective connected to said first network depending on the instructions directed to said second network by an instructing apparatus (Fig 1, 43) connected to said first network for said apparatuses of control objective.

While Edson fails to specifically disclose that the gateway apparatus comprises: monitoring means of monitoring the flow of the instructions for controlling the operation of said apparatuses of control objective, and control signal outputting means of outputting a control signal for controlling the operation of said apparatuses of control objective to said apparatuses control objective depending on the instructions when said flow of the instructions is monitored by said monitoring means, these limitations are inherent. Edson discloses that commands for controlling the devices are sent by the instructing apparatus (PC) to the gateway (Col 7, Lines 51-54), and that the commands

are received by the devices to be controlled (Col 7, Lines 45-47). A monitoring means of monitoring the control instructions as well as a control signal outputting means to send the instructions to the devices must be present in order for the gateway to determine what instructions need to be sent to the devices and send them. Therefore, these elements are present in the system disclosed by Edson, despite the lack of a specific reference to them. However, Edson fails to disclose that the instructions are directed to said second network by said instructing apparatus.

Daniels discloses a system for scheduling a VCR to record a program by selecting the program from a web site and notifying a service gateway to schedule the VCR to record the chosen program according to the required parameters such as time and channel (Par. 133-138 and Fig. 8-13). Edson discloses that VCRs can be used as devices for control (Edson, Col 7, Lines 47-49). The functionality disclosed by Daniels would be a greatly advantageous addition to the system disclosed by Edson. This allows users to program a VCR connected to the local network to record a program by simply selecting it from a program guide on a web site (Fig 24). Acquiring the program information from a website ensures that the program listing is up to date and the automatic programming of the VCR makes it much simpler for the user, since it does not need to be programmed manually.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the system disclosed by Edson to include the functionality disclosed by Daniels to program a VCR connected to the network. Using Daniels' method and accessing a program guide via the Internet would have ensured access to an up to date

programming guide and made programming the VCR much simpler for the user.

19. With regard to claim 2, Edson further discloses control information setting means in which control information for controlling the operation of said apparatuses of control objective is set (Control information is set in gateway using PC) (Col 7, Lines 51-54), wherein said control signal outputting means outputs said control signal by using said control information set in said control information setting means (Parameters are referenced for control, such as user's desired temperature) (Col 15, Lines 33-39).

20. With regard to claim 3, Edson further discloses that said control information is set in said control information setting means by an access from said instructing apparatus (PC is used to change settings) (Col 7, Lines 51-54), by a user's input operation (User changes setting via PC) (Col 7, Lines 51-54), or by an access from said apparatuses of control objective (Devices report their current status so desired changes can be determined) (Col 7, Lines 45-47).

21. With regard to claim 4, Edson further discloses identification information storing means of storing the identification information of each of said apparatuses of control objective (New devices are identified and configured) (Col 11, 9-19), While, Edson fails to specifically disclose that said control signal outputting means outputs said control signal by using said identification information stored in said identification information storing means, this limitation is inherent. Since a control signal must be directed to the correct device to be effective, the control signal outputting means must use the identification means to determine which device should receive the control signal.

22. With regard to claim 5, Edson further discloses that said identification information

is stored in said identification information storing means by an access from said instructing apparatus, by a user's input operation, or by an access from said apparatuses of control objective (New devices identify themselves to the gateway) (Col 11, 9-19).

23. With regard to claim 6, Edson further discloses device identification information acquiring means of acquiring said identification information of each of said apparatuses of control objective from all or a part of said apparatuses of control objective, wherein said identification information storing means stores said identification information obtained by said device identification information acquiring means (New devices are automatically identified and configured by the gateway) (Col 11, Lines 9-19).

24. With regard to claim 7, Edson further discloses data converting means of converting the data from said second network into data available for said instructing apparatus (interface cards convert between protocols for different networks) (Col 10, Lines 55-59).

Conclusion

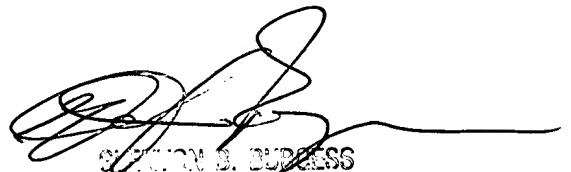
25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 703-305-8878. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.S. 6/30/2004



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